

BS030418

U.S. Application No. 10/733,192 Art Unit 2681
Submission of Amendment with RCE in Response to November 30, 2006 Final Office Action

REMARKS

In response to the final Office Action dated November 30, 2006, the Assignee respectfully requests continued examination based on the above amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents to *Paik*, *Urban*, and *Martensson*.

Claims 1, 3, 5-6, 8-13, and 15 are pending in this application. Claims 2, 7, and 14 having been canceled without prejudice or disclaimer.

The United States Patent and Trademark Office (the "Office") rejected claims 1, 3, 5-6, and 8-13 and 15 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,675,008 to *Paik et al.* in view of U.S. Patent Application Publication 2004/0209604 to *Urban et al.* Claim 7 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Paik* and *Urban* in view of U.S. Patent 5,553,125 to *Martensson*.

The Assignee shows, however, that the pending claims already recite features that are not taught or suggested by *Paik*, *Urban*, and *Martensson*. The pending claims, therefore, cannot be obvious over these documents, whether considered alone or in any combination.

Rejection of Claims Under 35 U.S.C. § 103

The Office rejected claims 1-3, 5-6, and 8-15 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,675,008 to *Paik et al.* in view of U.S. Patent Application Publication 2004/0209604 to *Urban et al.* The Office also rejected claim 7 under 35 U.S.C. § 103 (a) as being unpatentable over *Paik* and *Urban* in view of U.S. Patent 5,553,125 to *Martensson*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed

BS030418

U.S. Application No. 10/733,192 Art Unit 2681

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limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

For the following reasons, however, the *prima facie* cases for obviousness must fail.

1. All the Proposed Combinations Fail to Teach or Suggest All the Claimed Features, so the § 103 (a) Rejections Fail

The pending claims cannot be obvious. These claims already recite, or incorporate, features that are not taught or suggested by the combined teaching of *Paik* and *Urban*. Independent claim 1, for example, recites "*the base station discarding a voice portion of the outgoing call and wirelessly transmitting only called line identification information to the accessory device.*" Independent claims 8 and 13 recite similar features.

Any proposed combination of *Paik*, *Urban*, and/or *Martensson* cannot obviate this feature. Examiner Ekong is correct — *Paik* transmits "caller information" from a base station to a mobile terminal. Yet the proposed combination of *Paik*, *Urban*, and/or *Martensson* must also transmits a call to that same mobile terminal. *See* U.S. Patent 6,675,008 to *Paik et al.* at column 1, lines 43, 57-58, 60-65, and numerous other instances. Moreover, *Paik* also describes how a "paging signal" is sent to the mobile terminal. *Id.* at column 10, lines 3-12. The proposed combination of *Paik*, *Urban*, and/or *Martensson*, then, cannot obviate "*the base station discarding a voice portion of the outgoing call and wirelessly transmitting only called line identification information to the accessory device.*" Because the proposed combination of *Paik*, *Urban*, and/or *Martensson* fails to disclose at least this feature, one of ordinary skill in the art would not think that claims 1, 3, 5-6, 8-13, and 15 are obvious. Examiner Ekong is thus respectfully requested to remove the § 103 (a) rejection of these claims.

2. *Paik* "Teaches Away" and Cannot Support a *Prima Facie* Case

BS030418

U.S. Application No. 10/733,192 Art Unit 2681
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Paik “teaches away” and cannot support a *prima facie* case of obviousness. A reference that “teaches away” from the claimed invention is a significant factor when determining obviousness. *See* MPEP, at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. *See id.* at § 2141.02. “It is improper to combine references where the references teach away from their combination.” MPEP, at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* MPEP, at § 2143.01.

The Office’s *prima facie* case requires an impermissible change to *Paik*’s principle of operation. As the above paragraphs explained, *Paik*’s principle of operation is to transmit paging signals, “caller information,” and an accompanying call from a base station to a mobile terminal. *Paik*’s principle of operation would have to be changed to obviate “[discard] a voice portion of the outgoing call and wirelessly [transmit] only called line identification information to the accessory device.” The patent laws, however, forbid changes to a principle of operation to support a *prima facie* case of obviousness. Because such changes are impermissible, *Paik* cannot be used to obviate the pending claims. The Assignee thus respectfully requests removal of the § 103 (a) rejections of the pending claims.

3. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Cases for Obviousness Are Improper

The Examiner’s *prima facie* cases for obviousness are defective. The Examiner’s *prima facie* case for obviousness must include “a reasonable expectation of success.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner’s *prima facie* cases wholly fail to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* cases for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejections of the pending claims should be removed.

BS030418

U.S. Application No. 10/733,192 Art Unit 2681
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4. Because No "Teaching, Suggestion, or Motivation" was Cited, the § 103 (a) *Prima Facie* Cases for Obviousness Are Improper

The Examiner's *prima facie* cases for obviousness are defective for another reason. The Examiner's *prima facie* cases for obviousness must include "some teaching, suggestion, or motivation" to combine documents. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* cases wholly fail to include any "teaching, suggestion, or motivation" to combine documents. The Examiner, then, has failed to carry the burden, so the *prima facie* cases for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejections of the pending claims should be removed.

If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or scott@wzpatents.com.

Respectfully submitted,



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